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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,239	01/31/2002	Satoshi Mochizuki	219007US0	6551

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EXAMINER

NOTE, JANIS L

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/039,239Applicant(s)
MOCHIZUKI et alExaminer
J. DOTEGroup Art Unit
1756

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 6/10/03, 6/19/03; 6/20/03; 7/3/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-7, 9-19 is/are allowed.
- ☒ Claim(s) 8 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
 - ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 7, 9, 10
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. The examiner acknowledges the amendments to claims 1, 5, and 8, and the addition of claims 9-19, filed in Paper No. 8 on Jun. 19, 2003. Claims 1-19 are pending.
2. The reference US 6,368,765, which was listed on the form PTO-1449 filed in Paper No. 5 on Feb. 24, 2003, provided by applicants, has been considered by the examiner and is listed on the attached form PTO-892.
3. The examiner has considered only the material submitted by applicants, i.e., copies of the originally filed claims, abstract, and figures of the US applications listed in the Information Disclosure Statements filed in Paper Nos. 7 and 9 on Jun. 10, 2003 and Jun. 20, 2003, respectively.
4. The objection to the specification set forth in the office action mailed on Mar. 19, 2003, Paper No. 6, paragraph 2, item (1), has been withdrawn in response to the amendment to the paragraph beginning at page 2, line 15, of the specification, filed in Paper No. 8.

The rejection of claims 1-8 under 35 U.S.C. 112, second paragraph, set forth in Paper No. 6, paragraph 4, has been withdrawn in response to the amendments to claims 1, 5, and 8.

5. The disclosure is objected to because of the following informalities:

The use of trademarks, e.g., Lithol Rubine GX [sic: LITHOL Rubine GX] at page 10, line 35, has been noted in this application. The trademarks should be capitalized wherever they appear and be accompanied by the generic terminology. This example is not exhaustive. Applicants should review the entire specification for compliance.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

Applicants' arguments filed in Paper No. 8 have been fully considered but they are not persuasive. Applicants assert that the amendments to the specification filed in Paper No. 8 have capitalized the trademarks disclosed in the specification. However, as discussed above, the amendments did not capitalize all the trademarks disclosed in the specification.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claim 8 recites an electrophotographic color image forming apparatus comprising a photoconductor, and a developing unit wherein the developing unit comprises a toner vessel containing the dry toner according to claim 1.

Applicants state that "[c]laim 8 has been amended to clarify the apparatus and also the relationship between the the [sic] apparatus and the toner vessel, consistent with the specification. See, e.g., Figure 1 and the accompanying discussions on pages 4 and 17-18." See Paper No. 8, page 10, lines 12-14.

However, the originally filed specification does not provide an adequate written description of the claimed apparatus. The originally filed specification at page 4, lines 4-6, discloses that Fig. 1 represents an image forming apparatus comprising a one-component developing unit. The specification further discloses that the apparatus in Fig. 1 comprises a photoconductor

drum 1, and that the one-component developing unit comprises, in addition to a vessel 8 containing toner, a developer bearing member 2, such as a developing cylinder, a developer regulating member 4, a toner supplying member 3, and a stirrer blade 5 in the vessel 8. See the specification, page 17, line 27, to page 18, line 5. The photoconductor recited in instant claim 8 is broader than the disclosed photoconductor drum 1 because it includes photoconductors that are not drums, such as a plate. The developing unit recited in instant claim 8 is broader than the disclosed one-component developing unit in Fig. 1, because it includes two-component developing units, and one-component developing units that do not comprise the disclosed components of the developing unit in Fig. 1.

8. Claims 1-7 and 9-19 are allowable over the prior art of record for the reasons discussed in Paper No. 6, paragraph 5, which are incorporated herein by reference.

9. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (703) 308-3625. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (703) 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311 (Rightfax) for after final faxes, and (703) 872-9310 for other official faxes.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Palestine Jenkins, whose telephone number is (703) 308-3521.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

JLD
August 27, 2003

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1700